

U.S. Patent Application Serial No. 09/754,762

a powered conveyor, classified in class 198, subclass 346.1), and Group IV (claims 33-36, which are said to be drawn to "a product handling apparatus, classified in class 198, subclass 523). Reconsideration is respectfully requested.

The office action characterizes the invention of Groups I and II as drawn to a subcombination and combination, respectively. Referring to M.P.E.P. § 806.05(c), the office action states that the inventions are distinct "if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." With regard to the first element, the office asserts that the "combination as claimed does not require the particulars of the subcombination as claimed because Invention I does not require the computer subject matter as described in Invention II, for patentability." As for the second element, the office action states that "the subcombination has separate utility such as a computer-controlled sorting apparatus." This restriction requirement is traversed for the reasons stated below.

The office action also characterizes the invention of Groups I and III as drawn to a combination and subcombination, respectively. Applicants do not traverse this ground of restriction.

The office action further characterizes the invention of Groups I and IV as drawn to a combination and subcombination, respectively. Applicants do not traverse this ground of restriction.

Still further, the office action characterizes the invention of Groups II and III as drawn to a combination and subcombination, respectively. Applicants do not traverse this ground of restriction.

The office action also characterizes the invention of Groups II and IV as drawn to a combination and subcombination, respectively. Applicants do not traverse this ground of restriction.

The office action still further characterizes the invention of Groups III and IV as drawn to a combination and subcombination, respectively. Referring to M.P.E.P. § 806.05(c), the office action states that the inventions are distinct "if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." With regard to the first element, the office asserts that the "combination as claimed does not require the particulars of the subcombination as claimed because Invention III, directed towards a conveyor to transport items between workstations does not require the gravity conveyor sections for patentability." As for the second element, the office action states that "the subcombination has separate utility such as a conveyor with gravity conveyor sections." This restriction requirement is traversed for the reasons stated below.

**I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS ADMISSIONS CONCERNING PATENTABILITY**

The effect of the position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the subcombination of Group II, and *vice versa*. Similarly, the Patent Office admits that the Group III claims are patentable over a disclosure of the subcombination of Group IV, and *vice versa*. M.P.E.P. § 802.01 states that **the distinctness required for restriction means that the subjects, including "combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. §

808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed stock item transfer apparatus of the Group II claims is patentable over any disclosure of a stock item transfer method according to the Group I claims. *See, e.g.*, M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed stock item transfer method of the Group I claims is patentable over any disclosure of a stock item transfer apparatus according to the Group II claims. *Id.* Each of independent claims 1 of Group I, and 7 and 18 of Group II, includes similar elements, and therefore such admissions would appear to be improper.

Turning to the restriction between Groups III and IV, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed delicate product handling apparatus of the Group III claims is patentable over any disclosure of a delicate product handling apparatus according to the Group IV claims. *See, e.g.*, M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the delicate product handling apparatus of the Group IV claims is patentable over any disclosure of a delicate product handling apparatus according to the Group III claims. *Id.* Each of independent claims 29 and 33 includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicant during examination of this and continuing

applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

**II. THE STANDARD FOR REQUIRING RESTRICTION HAS NOT BEEN MET BECAUSE THE CRITERIA OF DISTINCTIVENESS HAVE NOT BEEN DEMONSTRATED**

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The restriction requirements between Groups I and II and Groups III and IV are improper because the criteria of distinctiveness in M.P.E.P. § 806.05(c) have not been demonstrated. To show distinctiveness, M.P.E.P. § 806.05(c) requires in part that "the combination as claimed does not require the particulars of the subcombination as claimed for patentability." In addition, M.P.E.P. § 806.03 advises that:

"where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween **should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth and scope of definition."

Under these requirements, the restriction between Groups I and II is improper.

Each of independent claims 1, 7, and 18 specifies similar elements for stock order methods and apparatus. More specifically, independent claim 1, which is classified in Group I, specifies a stock order method in which containers are assigned unique identifiers, lights located near bins are illuminated, stock quantities are displayed, containers are assigned, and container identifiers for the assigned containers are displayed.

Independent claims 7 and 18, which are classified in Group II, are directed to stock order filling apparatus having similar features as the method of claim 1. Claims 7 and 18 include lights associated with bins, a number display, and a container display, which are used to direct a stock worker to pick parts of an order. Accordingly, independent claims 1, 7, and

18 specify similar inventions, albeit with varying breadth and scope with regards to certain features. Restriction between the claims of Groups I and II, therefore, is improper.

Furthermore, the reasons provided in the office action for the distinctiveness of the Groups are unfounded. The office action asserts that the subcombination "has separate utility such as for computer-controlled sorting apparatus." It is well known in the art to provide computer controls to direct picking apparatus (see, e.g., Wunscher U.S. Patent No. 5,943,841), and therefore it is not seen how claims 1, 7, and 18 are patentably distinct.

Turning to the restriction between Groups III and IV, Each of independent claims 29 and 33 specifies similar elements for delicate product handling apparatus. More specifically, independent claim 29, which is classified in Group III, specifies a delicate product handling apparatus having a transfer conveyor, a plurality of trays movable to a discharge position, and a packing table for receiving items discharged from the trays.

Independent claim 33, which is classified in Group IV, is directed to a delicate product handling apparatus having similar features as the apparatus of claim 29. Claim 33 includes a transfer chute, a chute swing arm for directing items, and a packing table for receiving items directed by the swing arm. Accordingly, independent claims 29 and 33 have at least the following in common: (1) a transfer mechanism (i.e., conveyor in claim 29 and chute in claim 33); (2) a discharge mechanism (i.e., movable trays in claim 29 and a swing arm in claim 33); and (3) a packing table for receiving discharged items. Independent claims 29 and 33 specify similar inventions, albeit with varying breadth and scope with regards to certain features. Restriction between the claims of Groups III and IV, therefore, is improper.

For the foregoing reasons, the applicant traverses the restriction requirement on the grounds that the criteria of distinctiveness between Groups I and II and between Groups III and IV have not been demonstrated.

III. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirements asserted in the office action are improper on their face because they do not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. § 803 states:

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

The applicant thus further traverses the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required. Instead, the office action simply notes that the claims of Group I would be classified in class 209, subclass 546, while the Group II claims would be classified in class 700, subclass 223. Similarly, the office action does not allege any burden on the examiner with respect to Groups III and IV, but instead simply notes that the Group III claims would be classified in class 198, subclass 346.1, while the Group IV claims would be classified in class 198, subclass 523.

To the contrary, and in light of the common subject matter specified in the claims (as noted above), a complete search directed to the subject matter of the claims of Group I would require a search directed to the subject matter of the claims of Group II, and vice versa. Also, a complete search directed to the subject matter of the claims of Group III would require a search directed to the subject matter of the claims of Group IV, and vice versa.

Since search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicant and the Patent Office to prosecute these claims in separate applications. Search and examination of Groups I and II together, and of Groups III and IV together, would be much

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more efficient than requiring the Patent Office and the applicant to do so separately in four separate applications.

IV. PROPOSED ALTERNATIVE RESTRICTION


Instead of the Groups proposed in the Office action, applicants propose to restrict the claims into two groups: Proposed Group I consisting of claims 1-28; and Proposed Group II consisting of claims 29-36. Support for restricting the claims in this manner is provided above. Should the Examiner agree to restrict the claims as proposed, applicants would elect Proposed Group I, consisting of claims 1-28, for prosecution on the merits.

V. PROVISIONAL ELECTION WITH REGARD TO THE RESTRICTION REQUIREMENT

To satisfy 37 C.F.R. 1.143, the applicant hereby provisionally elects for examination on the merits, with traverse, the claims of Group II, i.e., claims 7-28. In doing so, the applicant does not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

Respectfully submitted,  
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September 16, 2002